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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/902,133	07/29/1997	LEONARD FORBES	303.356US1	9876
7590 06/01/2005 LUNDBERG WOESSNER & KLUTH P O BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER ECKERT II, GEORGE C	
			ART UNIT 2815	PAPER NUMBER
DATE MAILED: 06/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/902,133

Applicant(s)

FORBES ET AL.

Examiner

George C. Eckert II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35, 36, 39-71 and 73-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35, 36, 39-71 and 73-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/14/05, 3/7/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment dated January 10, 2005 in which claims 28, 29, 32, 39, 41, 42, 44-48, 51, 52, 57-60, 65, 66, 69, 70 and 73-78 were amended and claims 6, 15, 34, 37 and 72 were canceled has been entered.

### ***Claim Objections***

2. Claim 35 is objected to because of the following informalities: claim 35 still depends from claim 34 which claim was canceled. Claim 35 will be considered as depending from claim 32. Appropriate correction is required.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35-36 and 39-71 and 73-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-53 of U.S. Patent No. 6,031,263. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the claims of the '263 patent are more narrow than the instant claims and thus anticipate the instant claims.

5. Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-39, 59-61, 71-85, 98 and 99 of copending Application No. 09/691,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '004 application are more narrow than the instant claims and thus are anticipatory.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 8-15, 22, 24-29, 31-35, 37-48, 50-53 and 55-57 of copending Application No. 08/903,486. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the '486 application are to a species of device that anticipates the instant claims by providing a floating gate and insulator such that the barrier energy between them will be less than 3.3eV.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 2-5, 9, 10, 12-14, 20, 28, 32, 35-36, 40, 45, 47, 49, 51, 57, 59, 65, 69, 73, 75 and 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-31 of U.S. Patent No. 5,886,368. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the instant claims cite a broad genus that is anticipated by the species claimed in patent '368.

8. Claims 2-5, 8-10, 12-14, 18-20, 28, 29, 32, 35-36 and 39-71 and 73-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,249,020. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '020 patent are drawn to a memory device having specific materials which anticipate the instantly claimed device.

#### *Response to Arguments*

9. Applicant's arguments, filed January 10, 2005, have been fully considered and are persuasive, especially in light of the amendments. The obviousness rejections of all claims are withdrawn. Because the Double Patenting rejections remain, the case cannot yet be allowed.

#### *Conclusion*

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Eckert II whose telephone number is (571) 272-1728.

The examiner can normally be reached on 8:00 - 5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Thomas can be reached on (571) 272-1664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GEORGE ECKERT**  
**PRIMARY EXAMINER**